

Remarks:

The present amendment is in response to the first office action dated November 30, 2004 in the above-identified patent application.

In the first office action, claims 1-25 were pending, claims 1-12, 15, 16, and 19-25 remaining in this application, with claims 1-17 and 20-25 being rejected, with claims 18 and 19 being objected to, and claims 1, 15, 16, 19, 20, 21, and 25 having been amended and claims 13, 14, 17, and 18 having been cancelled.

In the office action page 2, paragraph 1, the Examiner objected to the drawings as the lines, numbers, and letters are not well defined, especially in Figures 2 and 3 having smeared lines.

In response, a set of formal replacement drawing sheets is submitted wherein there have not been any material amendment changes to the replacement drawing sheets.

In the office action page 3, paragraph 3, the Examiner stated that claims 1, 7, 8, and 9 are rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 3,016,034 to Raistakka who discloses a marine mooring line vermin shield 10 preventing the passage of vermin along a mooring line from land to a pleasure craft. The Examiner stated that Raistakka has a disc 12 with an aperture 23 thru the central portion of the disc 12, wherein the aperture 23 is sized and configured for the mooring line, with the disc 12 also

including a radial slot and a pocket 18 that are coincident to the disc 12 axial axis, with the slot extending from the aperture 23 to the disc 12 periphery. The Examiner also stated that Raistakka has a closure 13 sized to insert into the slot in a closure pivotal movement around pivot pin 22 approximately parallel to the disc 12 axial axis with the closure 13 in a closed state (Figure 1) when inserted into the slot and is substantially flush with the disc 12 face, also the closure is adapted to extract from the slot reverse from approaching the closed state into the open state, wherein the mooring line can pass through the slot from the aperture 23 to the disc 12 periphery. The Examiner also stated that Raistakka discloses that the closure first end is substantially flush with the disc 12 periphery when in the closed state with the closure second end 26 adapted to partially compress the mooring line against the aperture 23 in the closed state, with the disc resisting axial movement along the mooring line with the disc 12 face generally perpendicular to the mooring line, Raistakka also having a means for urging (cord 30) the closure from the open state to the closed state. The Examiner also stated that Raistakka is considered to have a substantially smooth surface on the disc 12 face with the exception of the mooring line when the closure is in the closed state, wherein the vermin encounters the disc 12 face to help prevent passage of the vermin along the mooring line. Also the Examiner stated the Raistakka has an area of the disc 12 above end portion 20 as an area for placement of a pleasure craft registration number and that cord 30 is considered as part of the means for urging the closure, with cord 30 at its lower end being oriented substantially parallel to the slot radial axis as shown in Figure 1.

In response, claims 1, 15, 16, and 19 are amended and claims 13, 14, 17, and 18 are cancelled.

Continuing, in the office action page 6 paragraph 5 the Examiner rejected claims 2-4 under 35 U.S.C. 103(a), as being unpatentable over Raistakka in view of U.S. Patent No. 5,570,652 to Ferland as Raistakka is not disclosed as being constructed of a material with a density less than that of water thus enabling floatation, as Ferland teaches a disc made of plastic that will float and that it would have been obvious at the time of the invention to combine Raistakka and Ferland to a person with ordinary skill in the art. Also the Examiner stated that Ferland does not disclosure making the disc of polyethylene, polypropylene, and polyurethane materials, however that these materials are well known plastics and that it would have been obvious at the time of the invention to a person with ordinary skill in the art to use the above materials to make the disc of Raistakka.

In response, claims 1, 15, 16, and 19 are amended and claims 13, 14, 17, and 18 are cancelled.

In the office action page 7 paragraph 6 the Examiner also rejected claim 5 under 35 U.S.C. 103(a), as being unpatentable over Raistakka in view of U.S. Patent No. 2,421,151 to Johnstone as Raistakka does not disclose a lockable element to secure the closure in a closed state, however, Johnstone teaches a lock 6 and that it would have been obvious at the time of the invention to combine Raistakka and Johnstone to a person with ordinary skill in the art to substantially secure the closure in the closed state using lock 6.

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In response, claims 1, 15, 16, and 19 are amended and claims 13, 14, 17, and 18 are cancelled.

Further, in the office action page 7 paragraph 7 the Examiner rejected claim 6 under 35 U.S.C. 103(a), as being unpatentable over Raistakka and Johnstone as applied to claim 5 above and further in view of Ferland as combined with Raistakka for claim 2.

In response, claims 1, 15, 16, and 19 are amended and claims 13, 14, 17, and 18 are cancelled.

Continuing, in the office action page 7 paragraph 9 the Examiner provisionally rejected claims 1-17 and 20-25 under 35 U.S.C. 101 as claiming the same invention as that of claims 1-17 and 19-24 of copending Application No. 10/604,526. The Examiner also stated that claims 5, 6, and 20 of the instant application claim a lockable element as opposed to the lock claimed in claims 5, 6, and 19 of copending Application No. 10/604,526 and are considered to be claiming the same invention, similarly in claim 11 of the instant application the verbiage "further comprising" and the verbiage "further including" in claim 11 on copending Application 10/604,526 are considered to be claiming the same invention. Further, the Examiner stated that in claim 21 of the instant application the verbiage "using said lockable element" with respect to the language found in claim 20 of copending Application 10/604,526, however, since the step of locking the closure in the closed state after step f would require using the lock claimed in claim 19 of the copending Application 10/604,526 or using the lockable element claimed in claim 20 are considered as claiming the same invention.

In response, claims 1, 15, 16, 19, 20, 21, and 25 are amended and claims 13, 14, 17, and 18 are cancelled.

Yet further, in the office action page 8 paragraph 10 the Examiner stated that claims 18 and 19 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In response, claim 1 has been amended to incorporate the limitations of claims 13, 14, 17, and 18, with claims 13, 14, 17, and 18 being cancelled, and claims 15, 16, and 19 being amended to depend from claim 1 instead of depending from cancelled claims 14 and 18.

Detailed explanation of reference teachings and amendment remarks

In the office action page 3, paragraph 3, the Examiner stated that claims 1, 7, 8, and 9 are rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 3,016,034 to Raistakka who discloses a marine mooring line vermin shield 10 preventing the passage of vermin along a mooring line from land to a pleasure craft. The Examiner stated that Raistakka has a disc 12 with an aperture 23 thru the central portion of the disc 12, wherein the aperture 23 is sized and configured for the mooring line, with the disc 12 also including a radial slot and a pocket 18 that are coincident to the disc 12 axial axis, with the slot extending from the aperture 23 to the disc 12 periphery. The Examiner also stated that Raistakka has a closure 13 sized to insert into the slot in a closure pivotal movement around pivot pin 22 approximately parallel to the disc 12 axial axis with the closure 13 in a closed state (Figure 1)

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when inserted into the slot and is substantially flush with the disc 12 face, also the closure is adapted to extract from the slot reverse from approaching the closed state into the open state, wherein the mooring line can pass through the slot from the aperture 23 to the disc 12 periphery. The Examiner also stated that Raistakka discloses that the closure first end is substantially flush with the disc 12 periphery when in the closed state with the closure second end 26 adapted to partially compress the mooring line against the aperture 23 in the closed state, with the disc resisting axial movement along the mooring line with the disc 12 face generally perpendicular to the mooring line, Raistakka also having a means for urging (cord 30) the closure from the open state to the closed state. The Examiner also stated that Raistakka is considered to have a substantially smooth surface on the disc 12 face with the exception of the mooring line when the closure is in the closed state, wherein the vermin encounters the disc 12 face to help prevent passage of the vermin along the mooring line. Also the Examiner stated the Raistakka has an area of the disc 12 above end portion 20 as an area for placement of a pleasure craft registration number and that cord 30 is considered as part of the means for urging the closure, with cord 30 at its lower end being oriented substantially parallel to the slot radial axis as shown in Figure 1.

A 35 U.S.C. 102(b) rejection requires complete claim anticipation by a single reference, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Also, "The identical

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invention must be shown in as complete detail as is contained in the...claim."

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Plus, the elements must be arranged as required in the claim, however, identical terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Raistakka generally teaches a rat guard for mooring lines that has a two piece clamshell type arrangement for the disc 12, wherein the disc 12 halves pivot 22 in an axis parallel to the mooring line lengthwise thus allowing a radial clamp upon the mooring line from the two disc 12 halves, with the radial clamp being urged by a weight 32 connected to a cord 30 that pulls the two disc 12 halves together by gravity. Raistakka also has a pocket 18 that receives a straight edge 17 thus allowing the two disc 12 halves to be in an overlapping relation to each other for more secure mooring line clamping, reference column 1, lines 54-64 to column 2, lines 1-2.

In response, claim 1 has been amended to incorporate the limitations of claims 13, 14, 17, and 18, with claims 13, 14, 17, and 18 being cancelled, and claims 15, 16, and 19 being amended to depend from claim 1 instead of depending from cancelled claims 14 and 18, as the Examiner has indicated that claim 18 would be allowable if rewritten in independent form, claim 1 should now be allowable. Also, as claims 7, 8, and 9 all depend from amended claim 1, claims 7, 8, and 9 should now be allowable.

Continuing, in the office action page 6 paragraph 5 the Examiner rejected claims 2-4 under 35 U.S.C. 103(a), as being unpatentable over Raistakka in view of U.S. Patent No. 5,570,652 to Ferland as Raistakka is not

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disclosed as being constructed of a material with a density less than that of water thus enabling floatation, as Ferland teaches a disc made of plastic that will float and that it would have been obvious at the time of the invention to combine Raistakka and Ferland to a person with ordinary skill in the art. Also the Examiner stated that Ferland does not disclosure making the disc of polyethylene, polypropylene, and polyurethane materials, however that these materials are well known plastics and that it would have been obvious at the time of the invention to a person with ordinary skill in the art to use the above materials to make the disc of Raistakka.

In establishing a *prima facie* case of obviousness under 35 U.S.C. 103 it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been lead to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the Applicant's disclosure. See, e.g., *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434 (Fed. Cir. 1991) (The teaching or suggestion to make the claimed combination must not be based on the Applicant's disclosure). For a proper rejection under 35 U.S.C. 103 all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ("All words in a claim must be considered in judging patentability of that claim

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against the prior art."). Obviousness under 35 U.S.C. 103 can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1998). The proposed modification for combining or individually modifying the prior art references cannot change the principal of operation of the references, if the principal of operation of the references is changed, then the teachings of the references are not sufficient to render the claim prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The motivation to modify the reference should manifest in some advantage or beneficial result, In re Sernaker, 702 F.2d 989, 994-95, 217 USPQ 1, 5-6 (Fed. Cir. 1983). Further, it should be noted that if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP §2143.03.

Ferland generally teaches a rodent guard having a flexible disc 18 having a radial slit 20, wherein the slit 20 is twisted slightly to open thus allowing the cable to slide from the disc periphery to a central opening 22, the disc 18 is secured to the cable by bands 32 over the slit 20 and a clamp 16 to secure the disc 18 axially to the cable, however, allowing the disc 18 to rotate, reference column 3, lines 35-50.

In response, claim 1 has been amended to incorporate the limitations of claims 13, 14, 17, and 18, with claims 13, 14, 17, and 18 being cancelled, and claims 15, 16, and 19 being amended to depend from claim 1 instead of depending from cancelled claims 14 and 18, as the Examiner has indicated that claim 18 would be allowable if rewritten in independent form, claim 1 should now be allowable. Also, as claims 2-4 all ultimately depend from amended claim 1, claims 2-4 should now be allowable.

In the office action page 7 paragraph 6 the Examiner also rejected claim 5 under 35 U.S.C. 103(a), as being unpatentable over Raistakka in view of U.S. Patent No. 2,421,151 to Johnstone as Raistakka does not disclose a lockable element to secure the closure in a closed state, however, Johnstone teaches a lock 6 and that it would have been obvious at the time of the invention to combine Raistakka and Johnstone to a person with ordinary skill in the art to substantially secure the closure in the closed state using lock 6.

Johnstone generally teaches a rat guard for ships cables utilizing a disc 18 similar to Ferland for the function of the slit 5, further utilizing doors 8 (being smaller than the disc) that radially clamp the cable similar to Raistakka, however, using springs 15 to urge the doors 8 radially against the cable.

In response, claim 1 has been amended to incorporate the limitations of claims 13, 14, 17, and 18, with claims 13, 14, 17, and 18 being cancelled, and claims 15, 16, and 19 being amended to depend from claim 1 instead of depending from cancelled claims 14 and 18, as the Examiner has indicated that claim 18 would be allowable if rewritten in independent form, claim 1

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should now be allowable. Also, as claim 5 depends from amended claim 1, claim 5 should now be allowable.

Further, in the office action page 7 paragraph 7 the Examiner rejected claim 6 under 35 U.S.C. 103(a), as being unpatentable over Raistakka and Johnstone as applied to claim 5 above and further in view of Ferland as combined with Raistakka for claim 2.

In response, claim 1 has been amended to incorporate the limitations of claims 13, 14, 17, and 18, with claims 13, 14, 17, and 18 being cancelled, and claims 15, 16, and 19 being amended to depend from claim 1 instead of depending from cancelled claims 14 and 18, as the Examiner has indicated that claim 18 would be allowable if rewritten in independent form, claim 1 should now be allowable. Also, as claim 6 ultimately depends from amended claim 1, claim 6 should now be allowable.

Continuing, in the office action page 7 paragraph 9 the Examiner provisionally rejected claims 1-17 and 20-25 under 35 U.S.C. 101 as claiming the same invention as that of claims 1-17 and 19-24 of copending Application No. 10/604,526. The Examiner also stated that claims 5, 6, and 20 of the instant application claim a lockable element as opposed to the lock claimed in claims 5, 6, and 19 of copending Application No. 10/604,526 and are considered to be claiming the same invention, similarly in claim 11 of the instant application the verbiage “further comprising” and the verbiage “further including” in claim 11 on copending Application 10/604,526 are considered to be claiming the same invention. Further the Examiner stated that in claim 21 of the instant application the verbiage “using said lockable element” with

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respect to the language found in claim 20 of copending Application 10/604,526, however, since the step of locking the closure in the closed state after step f would require using the lock claimed in claim 19 of the copending Application 10/604,526 or using the lockable element claimed in claim 20 are considered as claiming the same invention.

In response, claim 1 has been amended to incorporate the limitations of claims 13, 14, 17, and 18, with claims 13, 14, 17, and 18 being cancelled, and claims 15, 16, and 19 being amended to depend from claim 1 instead of depending from cancelled claims 14 and 18, as the Examiner has indicated that claim 18 would be allowable if rewritten in independent form, claim 1 should now be allowable. Also, as claims 2-17 all ultimately depend from amended claim 1, claims 2-17 should now be allowable. Further, in response, the current Application's claims 20, 21, and 25 are amended to distinguish the current Application's method claims 20-25 from the method claims 19-24 of copending Application No. 10/604,526 to address the provisional statutory double patenting rejection under 35 U.S.C. 101. Claim 20 is amended to add a fastener to the providing step and to add the step of inserting the fastener between the closure and the aperture insert to further retain the aperture insert to the closure after the step of engaging the aperture insert into the closure. Claim 21 is amended to articulate the change in method step identifying letters reflecting the added step of inserting as described above. Claim 25 is amended to add the inserting step as described above for the use of a selected aperture insert from a plurality of aperture inserts. Antecedent support in the current Application's specification for the amendments of the

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current Application's claims 20, 21, and 25 is found in Figures 1, 2, 3, 4, 8, and 9 related to element 105 and in paragraph 125.

Applicant respectfully requests that a timely notice of allowance be issued in this case.

Respectfully submitted,

Roger A. Jackson, Esq.

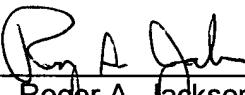
BY:



Roger A. Jackson
Registration No. 44,797
Customer No. 24254
800 Pennsylvania, Suite 1504
Denver, Colorado 80203-3185
USA
Phone: (303) 271-9468
Fax: (303) 216-2967
Email: rogerjackson@ricochet.com
Website: www.jacksonesquire.com

CERTIFICATE OF MAILING UNDER 37 C.F.R §1.8

I hereby certify that the attached **TRANSMITTAL OF REONSE TO
1st OFFICE ACTION, SIX (6) SHEETS OF DRAWINGS COMPRISING
EVEVEN (11) FIGURES, AND RETURN RECIEPT POST CARD** is being deposited with the United States Postal Service as prepaid first class mail in an envelope addressed to Mail Stop Non Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 30th day of March, 2005.



Roger A. Jackson